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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,853	09/04/2003	David Charles Lyons	12929.1122US02	8586
58506	7590	07/07/2006		
FAEGRE & BENSON, LLP ATTN: PATENT DOCKETING 90 SOUTH SEVENTH STREET 2200 WELLS FARGO CENTER MINNEAPOLIS, MN 55402			EXAMINER COCKS, JOSIAH C	
			ART UNIT 3749	PAPER NUMBER

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/656,853

Applicant(s)

LYONS ET AL.

Examiner

Josiah Cocks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 15-17, 19, 20, 22, 24-29 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-17, 19, 20, 22, 24-29 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. Receipt of applicant's amendment filed 4/13/2006 is acknowledged.

***Claim Objections***

2. Applicant is again advised that should claim 11 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,307,801 to Schroeter et al. ("Schroeter").

Schroeter discloses in the specification and Figs. 1-9 an invention in the same field of endeavor and as described in applicant's claim 33. In particular, Schroeter discloses a return air plenum (60) and a front panel assembly (at least casing panels, 20, 22, 24, 26, 28, see col. 3, lines 43-49) that is aligned with an opening of the plenum (see Fig. 4). Door (50) is disclosed as being attached to the panels (see col. 4, lines 32-40). Accordingly, the recited surround is considered to comprised of the casing panels (20, 22, 24, 26, and 28) as well as the door (50). Given this interpretation of the surround, the opening (74) which extends between the upper panel (24) and the top portion of the door (50) is considered to be an aperture that extends through a top member of the surround as recited. This aperture allows air to vent from the plenum through the top member of the surround (see at least col. 5, lines 22-34). Any of the space formed between the outer casing panels (20, 22, 24, 26, and 28) are considered to constitute the cavity as recited.

5. Claims 1-12, 15-17, 19, 20, 22, 24-29, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2004/0011352 to Bachinski et al. ("Bachinski").

Bachinski discloses in the specification and Figs. 1-3 an invention in the same field of endeavor as applicant's invention and as described in applicant's claims 1-12, 15-17, 19, 20, 22, 24-29, and 33. In particular, Bachinski shows a fireplace (100 or 400) and method forming the fireplace that includes providing a surround (461) for attachment to the fireplace wherein the surround includes first and second side members and includes an opening defined by the top member (see Fig. 3) and placed such that air from vents (460) is directed through the opening.

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The surround (461) includes a cavity (see space formed between surround fireplace front 403 and below upper horizontal portion of the surround) that is considered to be formed in a top member or first member of the surround as recited. Unnumbered louver portions adjacent the vents (460) that extend into the cavity are considered to be the shield as recited (see Fig. 3 and numbered lines to the right of the arrow identifying reference number 460). Activation panel (401) is provided in the cavity and is considered to be an insulating member (note discussion of thermal insulation as applied to similar panel 300, page 2, paragraph [0027]). The surround is molded from compression or vacuum molded materials and contains a ceramic fiber and binder (see page 3, paragraphs [0036] and [0038]).

In regard to at least claims 6, 7, 27, and 28, the unnumbered portion at the bottom of the surround (461) shown in Fig. 3 is considered to be the access panel as recited.

Bachinski also shows a return air plenum (514) that directs air through vent (460).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-5, 8-10, 12, 15, 17, 20, 22 24-26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,409,870 to Duffney ("Duffney") in view of U.S. Patent No. 5,307,801 to Schroeter et al. ("Schroeter").

Duffney discloses in the specification and Figs. 1-29 a decorative surround for a fireplace (see col. 2, line 7) in the same field of endeavor as applicant's invention and similar to that described in applicant's claims 1-5, 8-10, 12, 15, 17, 20, 22 24-26, and 29. In particular, Duffney shows an one-piece molded surround (see Fig. 1) that includes first and second side members that define a cavity (see Figs. 3 and 4 and note groove/cavity 24). Duffney further describes that that openings (such as 20) may be milled, routed or lazered as desired into the surround (see col. 4, lines 42-57). Duffney also discloses that an insulative filler (30) may be provided in the cavity (see Fig. 3).

In regard to the recitation of a shield, the walls of openings (20) would function to direct heat through the openings and are considered to be the shield as recited.

In regard to the recitation that the cavity is in fluid communication with a vent of a fireplace and that the opening is configured to exhaust the collected air, while Duffney discloses use of his decorative casing as a fireplace surround, no fireplace with a vent or heating source is disclosed.

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However, Schroeter is cited to show to the general arrangement of a fireplace (10) with vents and a heating source (38). In Schroeter, the fireplace (10) includes a surround (at least casing panels, 20, 22, 24, 26, 28, see col. 3, lines 43-49 and Fig. 1) arranged adjacent a vent of a fireplace (air exhausted from plenum 62). The surround includes an opening (74) arranged at the vent to exhaust collected air.

Therefore, the examiner considers that it would be obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the decorative surround of Duffney with the fireplace of Schroeter to desirably provide an artistic accent feature for the front of a fireplace (see Duffney, col. 1, lines 35-40 and col. 2, lines 5-9). In doing so, the surround of Duffney would be arranged such that the cavity (24) would be in communication with the vent of Schroeter. Further, in order to provide the exhaust feature of opening (74) in Schroeter a person of ordinary skill in the art would recognize that similar openings would be provided in Duffney as locations adjacent the vents by the milling, routing or lasering procedure disclosed in Duffney (see col. 4, lines 42-57).

9. Claims 6, 7, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffney in view of Schroeter as applied to claims 5 and 27 above, and further in view of U.S. Patent no. 6,026,805 to Burch et al. ("Burch").

Duffney in view of Schroeter disclose all the limitations of claims 6, 7, 27, and 28 except for a removably secured access panel.

Burch discloses a fireplace in the same field of endeavor as applicant's invention and Duffney. In Burch, a fireplace includes a front panel/surround with a lower opening (60).

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Access to burner controls (36) are provided through this opening (see Fig. 4). Burch explicitly provides that a removable access panel (39) is provide over this opening to cover the opening the burner controls (see col. 4, lines 5-7). The examiner notes that this arrangement of a lower opening and lower burner controls is substantially identical to that shown in Schroeter (note at least Fig. 7 and control 40). While Schroeter does not appear to discuss a covering for the opening (62, see Fig. 1) which provides access to control (40) the examiner considers that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a removable access panel as taught in Burch over the opening of Schroeter for the purpose of covering the opening after manipulation of the burner controls.

10. Claims 11, 16, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffney in view of Schroeter as applied to claims 1 and 22 above, and further in view of U.S. Patent No. 3758,317 to Moore ("Moore").

Duffney and Schroeter disclose all the limitations of claims 11, 16, 31, and 32 except that the molded material is a ceramic material with a binder and formed through compression molding. Duffney does however note that the material of the surround may be a variety of materials of any other material preferred (see col. 4, lines 20-23).

Moore teaches an article and method of making the article that is considered analogous to the problem of molding a surround for a fireplace. In Moore, an article that is useful for forming a monolithic structure for use as a facing, other decorative purposes, or for household burners (see col. 8, lines 68-72) is made of a ceramic material that includes a binder (see col. E, lines 10-



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31). Further, this article is made through vacuum or compression molding (see col. 8, lines 45-48).

Therefore, in regard to claims 11, 16, 31, and 32, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the molded surround of Duffney to be made of the material and in the manner disclosed in Moore to desirably provide a monolithic structure having a desired physical property suitable to function as a facing or burner portion (see Moore, col. 1, lines 187-25 and col. 8, line 68-72).

### ***Double Patenting***

11. The statutory ground of rejection of claims 22-33 has been overcome by the response filed 4/13/2006. This ground of rejection has been withdrawn.

12. Claims 1-21 were previously rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 34-51 of U.S. Patent No. 10/770,348 for the reasons that, despite some variance in wording, the claims of these two applications are claiming the same invention. This ground of rejection will be held in abeyance pending a patentability determination in either application.

### ***Response to Arguments***

13. Applicant's arguments filed 4/13/2006 have been fully considered but they are not persuasive.

In particular, applicant first argues that Schroeter does not show a aperture that extends through a top member of the surround. However, as noted above, as the door (50) of Schroeter is considered a portion of the surround, the opening (74) extending between the top casing panel (24) and the door (50) is considered to be extending through a top member of the surround as recited.

Applicant also argues that Bachinski does not show a shield member and/or insulating member that are within a cavity positioned within the top member of the surround. Applicant asserts that the surround (461) that fits over the front of the fireplace does not define a cavity as recited. The examiner does not agree. Webster's II New Riverside University Dictionary (1988) defines "cavity" as "a hollow or hole." The examiner considers that the space formed between the front face and the top horizontal member of the surround (461) in Bachinski is considered a hollow and is therefore properly considered a "cavity" as recited (see Fig. 3 of Bachinski).

Applicant also argues that the cutouts (20) of Duffney would not allow for venting of air from a fireplace because of the presence of filler (30). However, the examiner notes that Duffney has been applied in combination of Schroeter at least in part to obtain applicant's invention. The examiner has considered that when the surround of Duffney is arranged on a fireplace, such as that of Schroeter, additional cutouts would be provided, in the manner taught in Duffney, in order to provide the venting of air from the return air plenum (60) taught in Schroeter.

The teachings of Moore have not been disputed by applicant. Accordingly, Moore is properly considered to show that for which it has been cited.

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Accordingly, applicant's claims are not considered to patentably distinguish over the prior art of record.

*Conclusion*

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

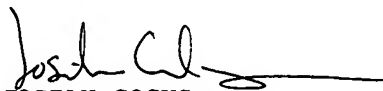
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Josiah Cocks whose telephone number is (571) 272-4874. The examiner can normally be reached on weekdays from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg, can be reached at (571) 272-4828. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jcc  
June 29, 2006

  
JOSIAH COCKS  
PRIMARY EXAMINER  
ART UNIT 3749